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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/537,816 03/28/00 GENHEIMER

S 22993

EXAMINER

LM01/0705

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KLIMOWICZ, W

ART UNIT

PAPER NUMBER

2754

DATE MAILED:

07/05/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/537,816

Applicant(s)

GENHEIMER ET AL.

Examiner

William J. Klimowicz

Art Unit

2754

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some \* c) ☐ None of the CERTIFIED copies of the priority documents have been:
1. ☐ received.
2. ☐ received in Application No. (Series Code / Serial Number) \_\_\_\_.
3. ☐ received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

## Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

**DETAILED ACTION*****35 USC § 112 Sixth Paragraph***

This application contains claims apparently invoking 35 U.S. C. 112 sixth paragraph (i.e., means-plus-function). In order to satisfy 35 U.S.C 112 second paragraph, the written description must link or associate particular structure, material or acts to the function recited in the means-(or step-) plus-function claim limitation. 37 CFR 1.75(d)(1) provides, in part, that “the terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description.” In the situation in which the written description only implicitly or inherently sets forth the structure, material or acts corresponding to a means-(or step-) plus-function, and the Examiner concludes that one skilled in the art would recognize what structure, materials, or acts perform the function recited in a means-(or step-) plus-function, the Applicant should clarify the record by amending the written description such that it expressly recites what structure, material or acts perform the function recited in the claim element. (See Federal Register/ Vol. 65, No. 120/ Wednesday, June 21, 2000/ Notices/ pp.38510-38516 “Supplemental Examination Guidelines for Determining the Applicability of 35 U.S.C. 112, paragraph 6).

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claim 18 is rejected under 35 U.S.C. 102(e) as being anticipated by Alt (US 5,422,770).

As per claim 18, Alt (US 5,422,770) discloses a rotatable disc (102); a pivotable actuator supporting a read/write head in a data reading and writing relationship with the disc (102) and limit means (corresponding to at least element (124) of Alt (US 5,422,770) supported by the actuator for limiting deflection of the disc in response to application of a non-operational shock to the disc drive (100).

The Examiner vigorously maintains, that at the very least, the limit means (124) (e.g., see FIG. 4 of Alt (US 5,422,770)) not only carries out the identical function for the identical reason as the instant application. Any difference in the shape of the limit means (124) (when compared to the corresponding structure of the instant application, e.g., FIGS. 9-11 of the instant application) is an insubstantial change which adds nothing of significance to the prior art element.

The limit means (124) of Alt (US 5,422,770):

(i) performs the same function specified in the claim in substantially the same way, producing substantially the same results as the corresponding element(s) disclosed in the specification.

(ii) one of ordinary skill in the art would have readily recognized the interchangeability of at least element (124) of Alt (US 5,422,770) with the corresponding elements of the instant application.

(iii) the element (124) physically appears to be, if not nearly identical, then an insubstantial variation of the corresponding elements (e.g., FIGS. 9-11) of the instant application.

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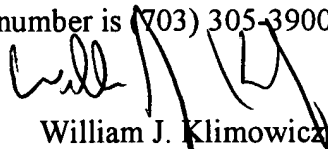
*Conclusion*

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William J. Klimowicz whose telephone number is (703) 305-3452. The examiner can normally be reached on M-F (6:30AM-5:00PM).

The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-9051 for regular communications and (703) 308-9051 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

  
William J. Klimowicz  
Primary Examiner  
Art Unit 2754

WJK  
June 30, 2000